

### **REMARKS**

This responds to the Office Action mailed on September 26, 2003. Claim 1 is amended. Claims 1-5, 26, 28, 30 and 37-42 remain pending in this application. Support for the amendment to claim 1 can be found at page 7, lines 27-29 and at page 11, lines 29-31.

#### **Claim Objections**

Claims 2-5, 26, 28 and 30 were objected to as being dependent on a rejected base claim 1. Applicant respectfully submits that the discussion of claim 1 herein is believed to clarify the patentability of claim 1 and its dependent claims.

#### **§112 Rejection of the Claims**

Claim 1 was rejected under 35 USC § 112, first paragraph, as failing to comply with the written description requirement. The rejection asserted that the claim contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 1 was also rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Applicant respectfully traverses the rejections, but has amended claim 1 to remove the limitation “not an adhesive.” It is believed that the claims are allowable in view of 35 USC § 112. Therefore, Applicant respectfully requests withdrawal of the rejections.

#### **§103 Rejection of the Claims**

The obviousness rejections from the Office Action assert that the text of claim 1 that reads: “when used as a coating on an implantable cardiac stimulus electrode” is an “Intended Use” and “not treated with merits for patentability.” Applicant respectfully traverses the characterization of claim 1 and requests reconsideration of the claim as amended.

Claims 1-5, 26, 28, 30 and 37-42 were rejected under 35 USC § 103(a) as being unpatentable over U.S. Patent No. 5,354,790 to Keusch *et al.* (“the “790 patent” or “Keusch”).

The rejection concludes: “It would have been obvious for a person of ordinary skill in the art to make modifications to the compositions and/or preparative methods of Keusch et al by choice of design, because both the compositions taught by Keusch et al and that claimed by the applicants are in the analogous art of coatings for medical electrodes, and to obviously arrive at the limitations of the instant claims by the applicants with reasonable expectation of success.”

Applicant respectfully traverses this rejection.

To the extent that this single reference §103 rejection is based on the Examiner’s personal knowledge of the design of medical electrodes, Applicant objects to the Examiner’s reliance on Official Notice and respectfully requests a reference supporting such a teaching or suggestion. See MPEP §2144.03.

In addition, the composition recited in the pending claims is not obvious in view of the ‘790 patent because Applicant can not find in the ‘790 patent an “ionically conductive polymeric composition wherein the ionic medium is adapted for reversible reduction-oxidation reactions” as recited in amended claim 1.

Accordingly, Applicant requests withdrawal of the rejection under 35 USC § 103(a) and reconsideration and allowance of all pending claims.

**CONCLUSION**

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612) 359-3265 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.


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By his Representatives,

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Date 12-29-03

By   
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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop AF, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 29 day of December, 2003.

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